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APR 17 2006

OFFICE OF PETITIONS

In re Application of
Leighton, et al.
Application No. 09/867,141
Filed: 30 May, 2001
Attorney Docket No.: 12293:34

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ON PETITION

This is a revised decision on the petition filed on 27 March, 2006, considered as a request to withdraw of the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below: the petition as considered under 37 C.F.R. §1.181 is
DISMISSED.

NOTES:

(1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(b)¹ (as

¹ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)."

(2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

A review of the record indicates that:

- Petitioner failed to reply timely and properly to the Notice of Allowance and Fees Due and Notice of Allowability on 11 August, 2005 (as to the Drawing Requirement) with reply due under a non-extendable deadline on or before 14 November, 2005;
- the instant application went abandoned after midnight 14 November, 2005;
- the Office mailed the Notice of Abandonment on 17 March, 2006;
- Petitioner filed, *inter alia*, the instant petition to revive on 27 March, 2006, with fee authorization and a reply in the form of drawings, and indicated that he previously had submitted drawings—on 24 January, 2002—and the Office clearly ignored the fact that there was no need to reply to the 11 August, 2005, drawings requirement, for which reason the holding of abandonment should be withdrawn and his petition fee should be returned.

Notably, Petitioner does not suggest that he—at any time after the mailing of the Notice of Allowance—replied to the drawing requirement set forth by the Examiner in that 11 August, 2005, Office action.

And, of course, Petitioner did not.

As one registered to practice before the Office, Petitioner is aware that an Office action mailed by the Examiner requires a reply, and whether that reply was simply to direct the Examiner's attention to a previously filed paper or to provide an additional copy of that paper—with or without an inquiry as to whether additional action was required of the Petitioner so as to demonstrate a *bona fide* effort to reply to the drawings requirement following the Examiner's Amendment (see: *inter alia*, MPEP §1302.03)—a reply was required.

Moreover, the record is silent as to any action by the Examiner to invalidate the Notice of Abandonment, which action reason requires to have been contemporaneous and the Rules of Practice require to have been in writing (see, inter alia: 37 C.F.R. §1.2²).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁴

Delays in responding properly raise the question whether delays are unavoidable.⁵ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁶ And the Petitioner must be diligent in attending to the matter.⁷ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

² The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

³ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁴ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁵ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁶ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁷ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁸))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁹

The commentary at MPEP §711.03(c) provides:

* * *

**B. Petition To Withdraw Holding of Abandonment Based on
Evidence That a Reply Was Timely Mailed or Filed**

37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as “Express Mail.” A petition to withdraw the holding of abandonment relying upon a timely reply placed in “Express Mail” must include an appropriate petition under 37 C.F.R. §1.10(c), (d), * (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the “Express Mail” procedures, the paper must be entered in PALM with the “Express Mail” date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered

⁸ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one’s attention and the mail is not timely deposited for shipment.

⁹ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R. §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.

* * *

Thus, Petitioner appears not to have satisfied the showing requirements described above because Petitioner failed to reply.

Thus, Petitioner has failed to carry his burden in this matter so as to obtain relief under the provisions of 37 C.F.R. §1.181 and relief cannot be granted under the provisions of 37 C.F.R. §1.181.

CONCLUSION

Because Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer and within the regulation, the petition under 37 C.F.R. §1.181 hereby is **dismissed**, and the 17 March, 2006, Notice of Abandonment is maintained.

ALTERNATIVE VENUE

Petitioner's only alternative to irretrievable abandonment may be a petition alleging unintentional delay under 37 C.F.R. §1.137(b).¹⁰

Petitioner may wish to file such a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay. (See:
http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply (the amendment), the petition fee, and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." (The statement is in the form available online.)

Further correspondence with respect to this matter should be addressed as follows:¹¹

By mail: Commissioner for Patents¹²
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

¹⁰ The regulations at 37 C.F.R. §1.183 sets forth that waiver of the rules is "subject to such other requirements as may be imposed."

¹¹ On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. The old number is no longer in service and faxes sent to the old number are no longer forwarded—the new number, (571) 273-8300, is the only facsimile number recognized for centralized delivery. (For further information. see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf> .)

¹² To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to read "John J. Gillon, Jr.", with a stylized, looping flourish at the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions